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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,353	03/26/2001	Philip S. Siegel	067439-0111	4525
5073	7590	06/14/2005	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			FISCHETTI, JOSEPH A	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,353

Applicant(s)

SIEGEL

Examiner

Joseph A. Fischetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
4a) Of the above claim(s) 10-34 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

Election/Restrictions

Newly submitted claims 21-34 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 21 does not contain the identifying limitation of claim 1 and claim 1 does not contain the storing limitation of claim 21. Claim 34 does not contain the limitation of gathering while claim 1 does not contain the limitation of storing.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10-34 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7,9 are rejected under 35 U.S.C. 102(e) as being anticipated by
Haseltine.

Haseltine discloses a method for processing the local return of remotely purchased merchandise on the WWW (see Par. # 0025): more specifically, it discloses

1. the user is identified by the packing slip which he/she bears;
2. transaction history is linked to the bar code packing slip which is gathered when the bar code is read, one of the items of the transaction history which is gathered is statement of the return policy of the e-tailer see, par. 28;

3. the transaction history is called up by the associate in front of the walk-in returner and inherent is to show the returner what the terms a of the return policy is at this point as questions are inherent in any such return process.

4. by initiating the return process to the associate 24, the user has thus selected the transaction displayed by the statement of the return policy of the e-tailer.

Re claims 2,3: retrieving a user preference profile for the user is read as -the record on the retailer's site- because somewhere in that record is information which has some preference e.g. which credit card chosen to use versus cash (see par. 0037 for options for refunds).

Re Claim 4: notifying the retailer of the merchandise to be returned (retailer is notified via the associate 42).

Re claim 5: see par.0028 which discloses information yielded by the swiping of slip 26 which includes information on both buyer and seller, retailer return policy and shipper, buyer etc.

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RE claim 6 : slip 26 is read as the return shipping label because using it effects the item's return.

Re claim 7: see par. 0039 "such and such shipper" is notified of shipping request for return.

Re claim 9: see par. 0025 for Internet communication.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haseltine in view of Dodd.

Haseltine discloses a method for processing the local return of remotely purchased merchandise on the WWW (see Par. # 0025): identifying the user (swiping of packing slip 26 identifies the user; and gathers transaction information associated with the identified user (see Par.# 0028); displaying a transaction history associated with a user (see Para.# 0028, bar coded slip yields e.g. information surrounding the transaction history as a whole, one transaction is capable of qualifying as "the transaction history" if that one transaction is all that occurred); and initiating a returns process in response to selection of at least one individual transaction by the user

(swiping of the label 26 initiates the return process in response to the returnee selecting the product to be returned).

However, it does so in the context of the user being the point of return associate 42 rather than the customer. However, Dodd does disclose a user as the customer and thus displays return information to the user and causes him to select a return process see, col. 98 lines 42 et seq. displayed to him for selection. It would be obvious to modify the method of Haseltine to include the user driven self return process of Dodd and to provide a selection step, the motivation being the ability to return a product without the need of going to a third party and the ability to allow a user to choose the mode of return e.g. return exchange etc.

Re claim 8: Haseltine disclose the problem with returns in that the customer and client may be separated by the entire breadth of the country making shipping for small products e.g. cookies (paragraph 0026) non cost effective. Thus it would be an obvious choice to try to sell the product for the best possible price so as not to incur a total loss and the old and notorious way of effecting this is the use of an auction.

Re claims 2-7, 9 see above analysis.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

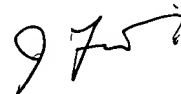
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to PRIMARY EXAMINER Joseph A. Fischetti at telephone number (703) 305-0731.



**JOSEPH A. FISCHETTI
PRIMARY EXAMINER**